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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/659,264

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Andrew J. Fischer

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 93-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 93-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicant's amendment filed June 9, 2005 is acknowledged. Accordingly, claims 93-128 remain pending.
2. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.
4. This application in an image file wrapper ("IFW") application. Applicant's response is therefore separated before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the Examiner highly recommends Applicant place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each* page submitted.

### ***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

5. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 93-128 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

- a. In claim 93, it is unclear if “wherein the message contains information regarding authorization or denial of the request to receive is conjunctive or disjunctive. For prior art purposes only, the Examiner interprets the phrase as a disjunctive phrase.
- b. In claim 106, it is unclear if “a request” as recited in line 13 is the same or different from “a request” in lines 3 and 4. If Applicant’s specification supports such an amendment, the Examiner suggests by way of example only reciting ‘a first request, . . . a second request’ etc.
- c. In claim 113, the phrase “processing a request to at least one of” does not make grammatical sense.
- d. Also in claim 113, it is unclear if “a request” as recited in line 12 is the same or different from “a request” in line 9.
- e. In claim 122, it is unclear if “a request” as recited in line 11 is the same or different from “a request” in line 9.
- f. In claim 123, it is unclear if “a sporting event” in lines 11 and 12 is the same or different from “a sporting event” as recited in line 4.
- g. In claim 126, it is unclear if “a sporting event” in line 10 is the same or different from “a sporting event” as recited in lines 4 and 5.
- h. In claim 127, it is unclear if “a subscription” as recited in line 5 is the same or different from “a subscription” as recited in line 2.

i. In claim 128, it is unclear if “a subscription” as recited in line 5 is the same or different from “a subscription” as recited in line 2.

j. In claims 102 and 113, it is unclear what is “a normal time period . . . .”

***Claim Rejections - 35 USC §102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 93-128, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Clarke, III et. al. (U.S. 6,535,857 B1)(“Clarke”). Clarke discloses the claimed invention including receiving, at a retail facility, information including a request to receive a periodical (the user desires to subscribe; processing the request (the user’s information such as name, address, etc. is entered into the POS terminal) with a processing device (the CPU within the POS device); the processing device determines a status of the subscription or the number of issues remaining (the processing device notes whether it’s a one, two, or three year subscription; generating a message in response to the information (generating the coupon, C11, L9-36) wherein the message contains information regarding the authorization; transmitting the

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message to a point-of-sale transaction device (the consumer takes the coupon to the POS device, step 218, C11, L50-63).

9. The Examiner notes that this application claims priority to 60/154,740 filed September 17, 1999 (the "Provisional Application"). The Examiner has reviewed the Provisional Application and, (at least for the current independent claims), can not locate all claimed features. Because the Examiner can not locate all claimed features and because the effective U.S. filing date of any pending non-provisional application that claims priority to a provisional application is on a claim by claim basis, the effective U.S. filing date of all currently pending claims is September 11, 2000. If Applicant can show where support in the Provisional Application is found (in accordance with 35 U.S.C. 112 1<sup>st</sup> paragraph) for the currently claimed features, thus allowing the current pending claims to have an effective U.S. filing date of September 17, 1999, all rejections using Clarke will then be withdrawn.

***Claim Rejections - 35 USC §103***

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 93-128, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Clarke.<sup>1</sup> It is the Examiner's principle position that the claims are anticipated because it is inherent that the subscription is to a periodical or event.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Clarke to include a subscription to a periodical or an event. Such a modification would have disclosed how e.g. magazine subscriptions are old and well known.

12. Claims 113-128, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Korman et. al. (U.S. 6,318,536 B1)("Korman"). Korman discloses receiving event tickets at unit 10 via the event ticket printer; an Internet connection; and two way connection with an event ticket system (Figure 5). Korman discloses the claimed invention but does not directly disclose that event tickets may be purchased via a subscription. The Examiner takes Official Notice that the purchase of event season tickets such as sporting event tickets for the entire season is a subscription purchase.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Korman to include printing out season tickets. By placing device 10 at sporting events, user's could not only purchase new tickets put pick up tickets that were on will call. Device 10 need only confirm the season ticket purchase via two way connection as shown in Figure 5. Such a modification would have automated the old and well known system of picking up tickets at a "will call" booth.

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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13. It is the Examiner factual determination that it is old and well known in the art to send automated messages in response to particular event(s) to various individuals, entities, processes, and/or locations. Such automated messages may be sent via email, fax, voice mail, text message See *e.g.* Fisher et. al. (U.S. 6,047,264); Janow (6,061,570); Hirsch (U.S. 5,978,799); Guck (U.S. 5,911,776); Linstead et. al. (U.S. 5,548,753); and Cohen (U.S. 4,837,798).

14. It is the Examiner's factual determination that it is old and well known in the art that lottery tickets can be sold by subscription. See *e.g.* Walker et. al. (U.S. 6,146,272).

15. Other than the definitions on page 27 of the original filed specification and because Applicant has not otherwise objectively indicated and redefined other claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner concludes that except for the definitions on page 27 of the original filed specification, Applicant has decided not to be his own lexicographer. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>2</sup> the Examiner has carefully reviewed the specification and prosecution history and (except for the definitions on page 27 of the original filed specification) can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to other definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and precision.<sup>4</sup>

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<sup>2</sup> See the "Second Non Final Office Action" mailed March 8, 2005, Paper No. 02242005, Paragraph No. 17.

<sup>3</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim



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Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>5</sup> Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>6</sup> to be his own lexicographer.<sup>7</sup> It remains the Examiner's position that these requirements were reasonable.<sup>8</sup> Accordingly and for due process purposes, the Examiner gives notice that for the

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with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See again the "Second Non Final Office Action" mailed March 8, 2005, Paper No. 02242005, Paragraph No. 17.

<sup>6</sup> Id.

<sup>7</sup> See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept.").

<sup>8</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed August 29, 2005).

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remainder of the examination process (and except for the definitions on page 27 of the original filed specification), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>9</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>10</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

### *Response to Arguments*

16. Applicant’s arguments filed with the claim amendments have been fully considered but they are not persuasive.

17. Moreover, Applicant's arguments with respect to the prior art and the claims have also been considered but are moot in view of the new grounds of rejection.

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<sup>9</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>10</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

*Conclusion*

18. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

20. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. Applicant also is reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicant is a skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant’s response must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant’s response is made of record) both Applicant’s request for understanding and the reasons as to *why* the request is made—and assuming the reference is

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germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

23. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

24. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks

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Applicant for his "Remarks" (beginning on page 24) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>11</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
August 29, 2005

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<sup>11</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.